ATTACHMENT A

Remarks

In response to the Office Action mailed on July 27, 2006, reconsideration of the rejection of the claims is respectfully requested.

A. Rejection of Claims under 35 U.S.C. § 112

Claims 2, 6, 10, 14, 22, 26, 30, 34, 38, 42 and 46 have been rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the applicant regards as the invention. Additionally, the rejection indicates that claim 8 is also rejected but provides no basis for the rejection, and omits claim 18 from the listing of rejected claims but provides description of the rejection of claim 18. The following remarks and amendments assume that claim 18 should have been identified instead of claim 8.

Claims 2, 18 and 34 were rejected as lacking sufficient antecedent basis for the limitation, "the passage of time." Claims 2, 18 and 34 have been amended to remove the limitation "the passage of time."

Claims 6, 10, 22, 26, 38 and 42 were rejected as lacking sufficient antecedent basis for the limitation, "the time of the negative response." The limitation "the time of the negative response" appearing in Claims 6, 10, 22, 26, 38 and 42 has been amended to overcome the rejection.

Claims 14, 30 and 46 were rejected as lacking sufficient antecedent basis for the limitation "the software characteristics." Claims 14, 30 and 46 have been amended to now recite the limitation "the detected software characteristics," which finds antecedent basis in claims 13, 29 and 45, respectively.

Thus, it is respectfully requested that the rejection of claims 2, 6, 10, 14, 18, 22, 26, 30, 34, 38, 42 and 46 be withdrawn.

B. Rejection of Claims under 35 U.S.C. 102(b)

Claims 1 – 15, 17 – 31, and 33 – 47 have been rejected under 35 U.S.C. 102(b) as being anticipated by Kenner (U.S. Patent No. 6,325,565). This rejection is

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respectfully traversed, although independent claims 1, 17, and 33 have been amended to more clearly identify and distinguish the claimed invention.

Amended claim 1 is directed to a method for offering alternative software, including the steps of: scanning a computer system of a user to detect fee-based software residing on the computer system; determining an expiration date for the fee-based software; and offering the user alternative software to the fee-based software based on the expiration date of the fee-based software. Reference is made to the Detailed Description of the Invention at page 3, lines 16 - 18 of the application, where the phrase "fee-based software" is defined as "software products that require payment of a fee to renew a license to use the software and/or for an update or upgrade of the software." Additionally, reference is made to the succeeding sentence where the phrase "expiration date of software" is defined as "the software license expiration date, a required update or upgrade date, or any other date on which a user is required to pay a fee to continue existing use or update or upgrade use of a software program." Thus, Claim 1, as amended, addresses fee-based software programs licensed only for specific time periods or requiring renewal. More specifically, amended claim 1 addresses the need for a method for providing alternative software to fee-based software on or about the time of the expiration date of the fee-based software (see, for example, the Background of the Invention, page 2, lines 7 – 9).

The Kenner reference teaches a software tool which allows a user to download audio / video player software from distributed Internet servers, and to identify and update multimedia software components, thereby providing access to multiple types of audio / video content (column 1, lines 11 – 15). A script file contains information on a variety of multimedia codecs, including the most recent version numbers, specific capabilities of each codec, network locations from which the codecs can be obtained, browser compatibility information, and instructions on how to automatically acquire and install each codec (column 6, lines 40 – 45). When a user wishes to update the codecs installed on his computer, the user initiates an updating program which searches for the script file. If a local script file exists and an expiration date set forth in the script has not yet passed, then the updating program reuses the local script file; otherwise the updating program automatically downloads a new script file (column 6, lines 57 – 68).

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The script file is then used to formulate a list of newly available and uninstalled codecs (column 7, lines 1 – 16). The user is then given the option to install all identified codecs or to select a subset to install (column 7, lines 48 – 50). The script file is provided with an expiration date to allow the script file to be updated so as to accommodate changes by codec providers in accessing the codec software (column 11, lines 8 – 16). Also, the codecs are typically available from codec providers who frequently make the codecs available to download free of charge (column 7, lines 55 – 57).

An important distinction between the method recited in claim 1 and the method of the Kenner reference is that the method recited in claim 1 is directed to a software vendor offering alternative software to expired fee-based software, while the method of the Kenner reference is directed at user-initiated updating of an information file that is then utilized to install audio/video software components (codecs). While the codecs of the Kenner reference might be characterized as software, the script file is merely an information file. Further, neither the script file or the codecs are fee-based. The expiration date is for the script file (information only), and not the software components. Further, the Kenner reference teaches that a new script file is downloaded automatically if the expiration date of the script file is expired. Thus, even if the script file were somehow characterized as the fee-based software of claim 1, the Kenner reference does not teach offering a user alternative software to the script file based on the expiration date of the script file. Therefore, the Kenner reference does not teach or suggest the following features recited in claim 1: (1) scanning a computer system to detect fee-based software residing on the computer system; (2) determining an expiration date for the fee-based software; and (3) offering the user alternative software to the fee-based software based on the expiration date of the fee-based software.

Withdraw of the rejection of claim 1 is respectfully requested. Further, independent claims 17 and 33 have been amended similarly to claim 1, and are also allowable over the Kenner reference for the reasons provided above in support of the allowability of claim 1.

Dependent claims 2 – 15, 18 – 31 and 34 – 47 depend from independent claims 1, 17 and 33 and thus are allowable for at least the reasons provided above in support

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of the allowability of claim 1. Additionally, as explained below, many of the independent claims are separately patentable over the Kenner reference.

For instance, claims 2, 18 and 34 add the limitation of "transmitting a message to a software vendor at predetermined time intervals prior to the expiration date, wherein the software of the user was not authored by the software vendor and is detected by a monitoring program." It is suggested in the Office Action that Kenner teaches this limitation at column 4, lines 30 – 40. However, it is respectfully submitted that the cited passage simply describes a software updating tool that analyzes and updates multimedia software at a user terminal when a user desires to update the configuration of the terminal with the latest multimedia software. It is respectfully submitted that the cited passage does not teach or suggest transmitting a message to a software vendor at predetermined time intervals prior to the expiration date, or the other limitations of claims 2, 18 and 34. Therefore, dependent claims 2, 18 and 34 are independently allowable over the Kenner reference.

Additionally, dependent claims 6, 10, 22, 26, 38 and 42 recite "renotifying the user of the offer for the alternative software at a specified time interval after the receipt of a negative response." It is suggested in the Office Action that Kenner teaches this feature at column 8, lines 20 – 30. However, it is respectfully submitted that the cited passage basically describes an automatic form filling function of the updating program that simulates responses that a user would have provided manually in completing a sequence of forms required to download an updated codec. There is no suggestion of renotifying a user of an offer for alternative software at a specified time interval after the receipt of a negative response, as recited in claims 6, 10, 22, 26, 38 and 42.

Dependent claims 8, 24 and 40 recite that a monitoring program determines the expiration date by scanning at least one of: the files corresponding to registration of the software by the user, file types associated with software, and an installation date of the software. It is suggested in the Office Action that Kenner teaches this limitation at column 11, lines 35 – 40. The cited passage is a portion of claim 1 of the Kenner reference that recites analyzing a script file having an expiration date to ascertain what software components are available based on information in the script file and information provided by a user. It is respectfully submitted that analyzing a script file

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having an expiration date to ascertain available software components is not the same as determining an expiration date, because ascertaining available software components is different from determining an expiration date. Additionally, even if the cited passage could be said to teach determining the script file's expiration date, the process would only require reading the date from the script file because the expiration date is an element of the script file. As indicated above, dependent claims 8, 24 and 40 recite determining the expiration date of the fee-based software by scanning files and information other than a file that merely has the expiration date as an element of the file. Thus, claims 8, 24 and 40 recite features that are distinguishable from merely reading the expiration date from a file.

Additionally, dependent claims 15, 31 and 47 recite installing a monitoring program on a computer system of a user and receiving notification of the expiration date of software on the computer system. It is suggested in the Office Action that the Kenner reference discloses installing a monitoring program on a computer system of a user in FIG. 1, element 118 and the related text. However, element 118 is identified and described as simply a "CODEC PROVIDER." It is unclear how the reference to a codec provider teaches or suggests installing a monitoring program on a computer system of a user. In fact, the teaching in Kenner of user initiation of the updating program appears to teach away from providing a monitoring program that monitors expiration dates for fee-based software since the monitoring program as recited in claims 15, 31 and 47 is not user initiated.

C. Rejection of Claims under 35 U.S.C. 103(a)

Claims 16, 32 and 48 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Kenner in view of O'Connor (U.S. Patent No. 6,931,548). This rejection is also respectfully traversed.

Claim 16 recites a method for detecting fee-based software on a computer of a user and offering alternative software, including the steps of: using a monitoring program installed on the computer to scan for fee-based software; determining the expiration date of the software; and offering replacement, complementary or supplementary software. Claims 32 and 48 contain essentially the same limitations as

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method claim 16, but relate instead to a system and a computer readable medium, respectively.

It is suggested in the Office Action that the Kenner reference teaches the monitoring program in column 4, lines 37 – 45 and determining the expiration date of the software in column 11, lines 35 – 40. Further, it is admitted that Kenner does not disclose offering replacement, complementary or supplementary software; and to make up this deficiency in Kenner it is suggested that O'Connor discloses replacement of a secondary software program by refusing to allow issuance of a key to permit continued use (column 3, lines 1 – 15).

As discussed above with respect to claim 1, it is respectfully submitted that the Kenner reference does not teach scanning for fee-based software and determining the expiration date of the fee-based software because: (1) Kenner's script file is not "fee-based software"; and (2) Kenner's script file expiration date is not an expiration date of fee-based software.

Considering the secondary reference, it is respectfully submitted that the O'Connor reference does not disclose offering replacement complementary or supplementary software, and therefore does not make up the admitted deficiency of the Kenner reference. The O'Connor reference discloses a system and method for enabling the vendor of a primary software program to limit the use of a secondary software program with its primary software program (See: Abstract). The passage of the O'Connor reference cited by the Examiner describes use of the secondary software program for a predetermined period of time and entry of a registration key obtained from the secondary vendor for use past that period of time, and limiting the use of the secondary software program. Replacement of the secondary software program is required, not offered, by refusing to allow issuance of a key to permit continued use (column 3, lines 3 – 6). It is respectfully submitted that the teaching in O'Connor of "requiring replacement of a secondary software program by refusing to allow issuance of a key to permit continued use" is not even remotely related to the features recited in claims 16, 32 and 48 of determining an expiration date of fee-based software and offering replacement, complementary or supplementary software.

Therefore, it is respectfully submitted that the Kenner and O'Connor references, even taken in combination, do not teach or suggest the limitations of claims 16, 32 and 48, and that claims 16, 32 and 48 are therefore allowable.

END REMARKS